

REMARKS

Upon entry of the present amendment, claim 2 will have been canceled and the subject matter thereof will have been incorporated into claim 1. Additionally, similar features will have been incorporated into independent claim 15. In addition, various of the claims will have been amended to clarify the recitations thereof without narrowing the scope of the claims. Finally, claims 16-21 will have been submitted for consideration by the Examiner.

In view of the herein contained amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection together with an indication of the allowability of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants respectfully thank the Examiner for accepting the drawings filed in the present application on December 24, 2003. Additionally, Applicants thank the Examiner for acknowledging their Claim for Foreign Priority under 35 U.S.C. § 119 and for confirming receipt of the foreign priority document in the present application.

Additionally, Applicants respectfully thank the Examiner for considering the documents cited in the Information Disclosure Statement of March 26, 2004 by returning the signed and initialed PTO-1449 Form that accompanied the Information Disclosure Statement.

Turning to the merits of the Official Action, the Examiner rejected claims 1, 2, 13, 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over NISHIKATA et al. (U.S. Patent No. 5,956,177) in view of ABE (U.S. Patent No. 6,778,330). Applicants

respectfully traverse the above rejection and submit that it is inappropriate with respect to the claims in the present application.

In the outstanding Official Action, the Examiner objected to claims 3-11 as being dependent upon a rejected base claim. However, the Examiner indicated that these claims would be allowable if rewritten into independent form including all the limitations of the base claim and any intervening claims. Applicants note the Examiner's indication with acquiescence and thanks and have rewritten claim 3 into independent form as new claim 21. In this regard, claim 3 does not contain the intervening limitations of claim 2, but is nevertheless submitted to be allowable.

Regarding the other objected-to claims, because Applicants submit, for reasons as will be set forth more fully hereinafter, that each of independent claims 1 and 15 are allowable, they respectfully decline at this point to rewrite claims 3-11 into independent form.

As noted above, the Examiner rejected claims 1, 2, 13, 14 and 15 under 35 U.S.C. § 103 as unpatentable over NISHIKATA et al. in view of ABE. Applicants respectfully traverse the above rejection and submit that even if the references can be combined as proposed by the Examiner (which Applicants do not accept), the disclosures thereof do not disclose the combination of features recited in Applicants claims.

Initially, Applicants note that U.S. Patent No. 6,778,330 to ABE is not available as a reference against the claims of the present application. In this regard, Applicants note that ABE was issued on August 17, 2004 which is well after the filing date of the present application. Thus, the ABE patent is available as a reference only based upon its filing

date of September 27, 2002 under the provisions of 35 U.S.C. § 102(e). Additionally, Applicants note that ABE is assigned to PENTAX Corporation which is the Assignee of the present application. Accordingly, since the § 103 rejection set forth by the Examiner is based upon the utilization of ABE under 35 U.S.C. § 102(e) because ABE and the present application are commonly assigned, ABE is not available as a reference thereagainst, in accordance with the provisions of 35 U.S.C. § 103(c). For this reason alone, it is respectfully submitted that the Examiner's rejection of the pending claims is inappropriate and should be withdrawn.

Moreover, even if the Examiner considers the disclosure of U.S. Published Patent Application No. US 2003/0072091 upon which ABE is based, Applicants foreign filing date antedates the filing date thereof.

Additionally, and independently of the above, Applicants have canceled claim 2 and included the substantive recitations thereof into each of claims 1 and 15. Thus, for this additional reason, claims 1 and 15 are clearly patentable even over the combination of NISHIKATA et al. and ABE asserted by the Examiner.

According to the features of Applicants invention as disclosed in, for example, Fig. 2, the zoom lens system which comprises lenses L2, L3 and L4, is positioned between focus plate 21 and eyepiece L2. At least this combination of features, as recited in the pending claims, is not taught, disclosed nor rendered obvious by any proper combination of NISHIKATA et al. and ABE.

As admitted by the Examiner, NISHIKATA et al. does not disclose a zoom lens system at all and thus cannot teach at least the above-noted feature. Further, ABE also does not disclose a zoom optical system located between a focal plate and an

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eyepiece. ABE merely discloses the zoom lens optical system (lens groups 1 and 2) positioned in front of the image pick-up device which he appears to consider to correspond to the focal plate. However, the zoom optical system is not positioned between the focal plate and an eyepiece. Accordingly, no proper combination of NISHIKATA et al. and ABE contains a disclosure adequate to render obvious the combination of features recited in Applicants claims.

For each of the above-noted reasons and certainly for all of the above-noted reasons, Applicants respectfully submit that the claims in the present application are clearly patentable over the combination of references cited by the Examiner.

By traversing the Examiner's rejection based on the deficiencies in the disclosure of the references, Applicants do not in any matter acquiesce in the availability of the ABE disclosure as a reference against the claims of the present application. Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection together with an indication of the allowability of all the claims pending in the present application, in due course. Such action is respectfully requested and is believed to be appropriate and proper.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have amended various of the claims to clarify the present invention and traversed the rejection.

In this regard, Applicants have pointed out that one of the cited documents is not available as a reference against the claims in the present application in accordance with the provisions of 35 U.S.C. § 103(c).

Applicants have also traversed the rejection based on the shortcomings and deficiencies of the disclosures of the references. In this regard, Applicants have discussed Applicants invention and have pointed out the features thereof not disclosed by the references. Applicants have further pointed out the significant shortcomings of the references with respect to the features claimed herein.


Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully request an indication to such effect in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

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Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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